

REMARKS

This responds to the Office Action mailed on February 16, 2006.

Claims 1, 2 and 20 are amended, claims 4-5, 8 and 13 are canceled; as a result, claims are 1-3, 6-7, 9-12 and 14-26 now pending in this application.

§112 Rejection of the Claims

1-3, 6-7, 9-12 and 14-26 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. The Examiner asserts that the limitation “wherein the film-forming agent has a concentration over 20 percent by weight” is not supported in the originally filed specification or claims. The Applicant has cancelled reference to this range.

Claims 1-3, 6-7, 9-12 and 14-26 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has objected to the terms “acrylate derivate” and “volatile silicone derivate” because “it is not clear what compounds would be encompassed by the terms ‘acrylate derivate’ and volatile silicone derivate’”. The Applicant disagrees for the reasons set forth. The term “volatile silicone derivate: is a term known to anyone skilled in the cosmetics field. “Volatile silicone derivatives” are cosmetic oils which are easily vaporizable. Known examples are compounds with a short carbon chain e.g. hexamethyldisiloxane or rings with 4 or 5 Si atoms e.g. cyclotetrasiloxane, cyclopentasiloxane (cf. e.g. Fey, Otte *Worterbuch der Kosmetik*, 4th ed., Stuttgart 1997, page 254, or Schrader, *Grundlagen und Rezepturen der Kosmetik*, Heidelberg 1989, pages 28, 29. English translations accompany this response.

Additional support for the Applicant’s assertion that the terms are well known to those skilled in the art include the following:

<http://makeupalley.com/product/userreviews.asp?id=303801>:

PLEASE READ -- VERY IMPORTANT !!! To any members that have questioned the integrity of this product and the fact that it contains silicone and whether it will clog pores and cause breakouts, the answer is A VERY BIG YES !!! And this is not just me saying this, but **Estee Lauder themselves have told me this. While silicone molecules are too large to penetrate pores, cyclomethicone, dimethicone, tryclomethicone and any other silicone derivate WILL CLOG PORES.** The molecules of these silicone derivatives do manage to get just under the walls of the pores and over time, usually a couple of weeks/months will clog and cause breakouts, even with thorough cleansing and regular facials... I had a facial at EL 3 months ago now and the facialist used Re-Nutriv even though I told her not to as it is too rich for my fickle combination skin (tending toward dry) and would make it breakout. Well she thought she knew better and used it anyway – my skin broke out terribly within days! I honestly could not leave the house for around 8 weeks as I had huge lesions that resembled cystic acne all over my face, in my hair-line and on my décolletage. I've never had cystic acne prior to this, just small hormonal pimples usually on my nose and chin (I'm 35) that heal within 2-3 days and go away. I knew there was something seriously wrong with my skin as these lesions did not heal and would become very sore and irritated if I tried to conceal with foundation/concealer. I finally succumbed after the 7 week point and phoned EL head office, where I was asked what skincare products I was using...

<http://www3.interscience.wiley.com/cgi-bin/abstract/104076803/ABSTRACT>

J Bajdala, U Miller, S Wartewig, K Winklerb - doi.wiley.com

... Experimental part Materials The synthesis of the **silicone derivate** (SIAC) used ...

The reactive **silicone derivate** was free of any inhibitors. ...

Support for use of acrylate derivate is as follows:

<http://www3.interscience.wiley.com/cgi-bin/abstract/104552311/ABSTRACT>

Hydrophilisation of silicone rubber for medical applications - group of 4 »

P Hron - Polymer International, 2003 - doi.wiley.com

... Hydrogels based on acrylic and methacrylic acid **derivate** Among the mostly common hydrogels are hydro- gels based on polyHEMA. They ...

Web Search - BI Direct

<http://www2.warwick.ac.uk/fac/sci/chemistry/cim/research/haddleton/posters/durham03rene.pdf>

Prepare other **acrylate-derivate** graft copolymers. • Synthesis of Poly(t-BuA)-g-PBuMA amphiphilic copolymers and their characterization by GPEC, ...

www2.warwick.ac.uk/fac/sci/chemistry/cim/research/haddleton/posters/durham03rene.pdf

PDF Biesterfeld Spezialchemie GmbH

File Format: PDF/Adobe Acrobat - View as HTML

Acrylate Derivate. Viscolam MAC 10. Acrylates copolymer. Viscolam SMC 20. Acrylates copolymer, Steareth-20. Polymere Verdicker zur Herstellung von Dusch- ...

www.biesterfeld-spezialchemie.com/docs/LP_LifeScience_Cosmetic.pdf - Similar

www.pfi.no/gary/Presentations/FinePapersMoutinho.pdf : See page 16 of the pdf presentation, items 2 and 4 in the table which refer to "Acrylate derivate." A copy of this presentation and page 16 is shown as Exhibit A.

The Applicant respectfully requests the Examiner to reconsider and withdraw the 112 grounds of rejection.

103 Rejection of the Claims

The Examiner has rejected claims 1-12 and 14-26 as being "unpatentable over US Patent 5,804,173 ('173)."

The Applicant disagrees for the reasons set forth. The '173 patent refers to completely different copolymers from those claimed in the application. The '173 patent describes a copolymer complex comprising:

- (1) a copolymer from A and B monomers;
- (2) a complexing fatty acid, and
- (3) a volatile hydrophobic solvent (see col. 2, 1, 13-19).

The monomer A in the '173 patent is :

t-butyl acrylate
t-butyl methacrylate
t-butylstyrene
t-ethylhexyl methacrylate

The monomer B in the '173 patent is:

NN-dialkylaminoethyl(meth)acrylate
NN-dialkaminopropyl(meth)acrylate
NN-dialkylaminopropyl(meth)acrylamide

In the claimed invention, the monomers, after restriction of claim 1 to ethyl acrylate/methylmethacrylate copolymers, are ethyl acrylate and methyl methacrylate. Both are different from the monomers described in the '173 patent. Furthermore, neither of the copolymers is complexed with a fatty acid. The Examiner responded by stating that in the Examiner's opinion, this difference was not "persuasive." The Examiner did not provide any support for this statement.

"The test is not whether each difference individually is obvious; rather, it is whether the claimed invention as a whole is obvious." In re Buehler (CCPA 1975) 515 F2d 134, 185 USPC 781.

The claimed invention is a copolymer complex that includes a copolymer and a fatty acid that has excellent temporary styling for hair and improved "wash off" features. The formulation described in the '173 patent describes copolymers that are different from what is claimed and a product that is water resistant and has no wash-off characteristics. The Examiner has not responded to this ground of the Applicant's assertion of non-obviousness.

The Examiner's reference of column 24 of the '173 patent is to a thickener, starting with column 23, line 39. The thickeners are crosslinked polymers, column 23, lines 40/41, and are described in greater detail in column 24, lines 5ff. Furthermore, ethacrylic acid is mentioned as a possible monomer for the thickener, but methylmethacrylic acid is not mentioned.

The '173 patent does not teach a use of the copolymer ethyl acrylate/methyl methacrylate. Furthermore, the claimed acrylate derivative is different from the thickener described in the '173 patent. Applicant asserts it was not obvious for a person skilled in the art to use the teachings of the '173 patent for a gel claimed herein. The Examiner has not responded to this ground of the Applicant's assertion of non-obviousness.

Moreover, the '173 patent does not teach a use of a non-ionic emulsifier for emulsifying the copolymer. Column 24, lines 60-64 of the '173 patent describes its copolymer as acting only as a carrier, as described in column 24, lines 60-64.

Furthermore, the Applicant could not find the Examiner's support for the '173 patent teaching the "copolymer and around 60% cyclomethicone." The examples in the '173 patent describe concentrations of 10.0% and 7.0%. The Examiner has not responded to this ground of the Applicant's assertion of non-obviousness.

CONCLUSION

Applicant respectfully submits that the Examiner withdraw the non-compliant status and examine the response as appropriate.

The Examiner is invited to telephone Applicant's attorney at (612) 373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 17 July 06

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17TH day of July 2006.

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